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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,133	01/30/2002	Yu-Cheun Jou	PA450C1	3837
23696 7590 02/09/2007 QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO, CA 92121			EXAMINER MEW, KEVIN D	
			ART UNIT	PAPER NUMBER
			2616	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		02/09/2007	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/09/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

us-docketing@qualcomm.com
kscanla@qualcomm.com
t_ssadik@qualcomm.com

Office Action Summary

Application No.

10/062,133

Applicant(s)

JOU, YU-CHEUN

Examiner

Kevin Mew

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

Detailed Action

Response to Amendment

1. Applicant's Remarks/Arguments filed on 9/18/2006 regarding claims 16-22 have been considered. Claims 16-22 are currently pending and claims 1-15 have been cancelled by applicant.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter.. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. **Claims 17, 22** are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 6 of prior U.S. Patent No. 6,389,000. This is a double patenting rejection.

Claim 17 of the instant application recites, the wireless transmitter comprising:

"a transmission subsystem for said modulated first code symbol subset on a first carrier frequency and said modulated second code symbol subsets on a second carrier frequency" (see Jou, claim 1, col. 11, lines 23-26).

Claim 22 of the instant application recites, a wireless transmitter comprising:

Art Unit: 2616

“said transmission subsystem includes a switch for selectively switching said first and second modulated code symbol subsets respectively onto a third carrier frequency” (see Jou, claim 6, col. 11, lines 47-50).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. **Claims 16, 18-21** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,389,000 (hereinafter Jou).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the applicant filing of the continuing application is voluntary and not the direct, unmodified result of restriction requirement under 35 U.S.C. 121 (i.e. without a restriction requirement by the examiner) and the claims of the second application are drawn to the “same invention” as the first application or patent. Moreover, although the conflicting claims are not

Art Unit: 2616

identical, they are not patentably distinct from each other because claim 16 of the instant application merely broadens the scope of the claim 1 of the Jou Patent by eliminating the elements and their functions of the claims as set forth below.

Claim 16 of the instant application recites, a wireless transmitter comprising:

“an encoder for encoding ... a demultiplexer for providing ... to provide modulated first code symbol subset and second code symbol subset” (see Jou, claim 1, col. 11, lines 8-22).

Claim 18 of the instant application recites, the wireless transmitter comprising:

“said first and second modulators repeat code symbol within said first and second code symbol subsets, respectively, according to a said respective code symbol rate” (see Jou, claim 2, col. 11, lines 27-30).

Claim 19 of the instant application recites, the wireless transmitter comprising:

“said transmission subsystem scales a respective energy of said first and second modulated code symbol subsets according to a respective amount of code symbol repetition” (see Jou, claim 3, col. 11, lines 31-34).

Claim 20 of the instant application recites, the wireless transmitter comprising:

“said first modulator includes a first interleaver having a first interleaver format dependent on a first code symbol rate, and said second modulator includes a second interleaver having a second interleaver format dependent on a second code symbol rate” (see Jou, claim 4, col. 11, lines 35-40).

Claim 21 of the instant application recites, the wireless transmitter comprising:

“said first modulator includes a first PN scrambler for scrambling said first code symbol subset according to a first code symbol rate, and said second modulator includes a second PN scrambler for scrambling said second code symbol subset according to a second code symbol rate” (see Jou, claim 5, col. 11, lines 41-46).

It has been held that the omission an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd.App.1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art. Moreover, the doctrine of double patenting seeks to prevent the unjustified extension of patent exclusivity beyond the term of a patent.

Response to Arguments

4. Applicant's arguments have been considered but are moot in view of the double patenting rejection indicated above.

Acknowledgement is made of the terminal disclaimer filed by applicant on 9/18/2006. However, it is noted by the examiner that filing a terminal disclaimer does not place the application in condition for allowance because the double patenting rejection to claims 17, 22 in the previous Office action was a statutory double patenting rejection rather than a non-statutory double patenting rejection, and hence cannot be overcome by merely filing a terminal disclaimer.

In light of the foregoing, claims 17, 22 stand rejected by the statutory double patenting rejection under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 6 of prior U.S. Patent No. 6,389,000.

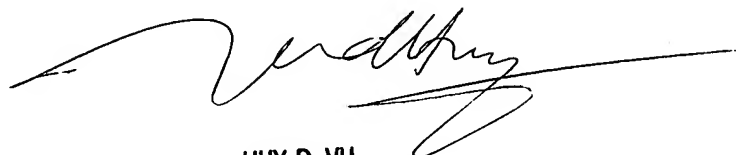
Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Mew whose telephone number is 571-272-3141. The examiner can normally be reached on 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin Mew 
Work Group 2616



HUY D. VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600